

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated February 25, 2008 (hereinafter Office Action) have been considered but are believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

The traversal of each of the rejections is maintained, and Applicant notes that the Office Action, in violation of MPEP § 707.07(f), fails to address each of the previously-asserted arguments. Specifically, MPEP § 707.07(f) requires that when a rejection is traversed and repeated, the examiner should answer the substance of the traversal. For example, in the previous response filed on November 21, 2007, it was explained that the conclusory assertion that the asserted binding data of Littleton would/could be synchronized separately is incorrect and would not correspond to the claimed invention. Without addressing at least these arguments, Applicant is denied an opportunity to judge the propriety of continuing the prosecution of the application. Thus, in addition to the arguments presented below, Applicant maintains each of the arguments presented in the previous response and incorporates them in their entirety herein.

Applicant respectfully maintains the traversal of each of the § 103(a) rejections, each of which depends upon the teachings of U.S. Publication No. 2003/0023759 by Littleton *et al.* (hereinafter "Littleton"), because Littleton does not teach or suggest each of the asserted claim limitations. As acknowledged at page three of the Office Action, Littleton fails to teach or suggest performing a second synchronization step to transfer binding data, as claimed in each of the independent claims. In an effort to overcome this deficiency, the Examiner asserts that a skilled artisan would synchronize binding data separately since "constructing a formerly integral structure in various elements involves only routine skill in the art". This assertion is inapplicable to the claimed process as the cited case law refers to physically constructing a device. Also, the assertion fails to address each of the missing claim limitations. For example, the claimed second synchronization step is performed in response to the performance of a first synchronization step. There is no suggestion that merely synchronizing binding data separately would be performed in

response to the performance of a first synchronization. Thus, the assertion that binding data could be synchronized separately fails to provide correspondence to each of the claimed limitations.

In addition, Littleton still has not been shown to teach or suggest forming binding between a user data unit of a first device and a function of a second device in the second device, as claimed in each of the independent claims. As explained previously, paragraph [0018] specifically states that use of the telephone-provisioning conduit does not interfere with use of existing PIM software residing on the PC (asserted as corresponding to the claimed second device) and therefore is used to synchronize the phone numbers stored in the PDA (asserted as corresponding to the claimed first device) with information residing on a server database separate from the PC (paragraph [0016] and Fig. 1). Also, there is no indication that a user data unit from the PDA would be arranged to be bound to a function of the PC in the PC. Since Littleton fails to teach a second synchronization step as claimed, Littleton also fails to teach forming binding with binding data received during a second synchronization step. Therefore, any binding of records accessed in the asserted first device is not performed in, and does not affect a function of, the asserted second device.

Moreover, the conclusory assertion that a skilled artisan would form “binding based on binding data received during a second synchronization step because two parts are needed to form a bond” fails to overcome the fact that Littleton does not teach forming binding in a second synchronization device (a device that receives a synchronized user data unit and binding data). No evidence has been presented that Littleton would be modified to bind items in the asserted second synchronization device based upon data received in a second synchronization step. Rather, Littleton teaches away from this by teaching that records accessed in the asserted first device are synchronized with information residing on a server database separate from the asserted second device. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejections are improper.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); and moreover, “[a]ll words in a claim must be considered in

judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See, e.g.*, MPEP § 2143.03. The Examiner appears to have ignored certain claim limitations such as those directed to forming binding in a second synchronization device, which are not taught by either of the cited references. Littleton does not teach forming binding in the asserted PC and no evidence has been presented to suggest otherwise. Since the asserted modification of Littleton is unsupported and Littleton fails to teach at least these limitations, the rejections are improper. Applicant accordingly requests that each of the rejections be withdrawn.

Dependent Claims 2-7, 10, 11, 13 and 14 depend from independent Claims 1, 9 and 12, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the above-discussed teachings of Littleton. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with the independent claims above. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-7, 10, 11, 13 and 14 are also patentable over the asserted teachings of Littleton.

With particular respect to the rejection of dependent Claims 3, 4, 5, 10, 11, 13 and 14, Applicant traverses because the asserted correspondence is inconsistent with the alignment of teachings in the rejection of the independent claims rendering a lack of presentation of correspondence to each of the limitations of these dependent claims. For example, the rejection of these dependent claims asserts that several of the elements asserted as corresponding to binding data, and the data which the binding data associates, correspond to multiple claim limitations at the same time such that the basis for the rejection of these dependent claims is illogical. Using Claim 3 as an example, a contact

record is asserted as corresponding to both binding data and a user data unit while a phone number is asserted as corresponding to both a user data identifier and a resource identifier. The asserted correspondence to the limitations of these dependent claims fails to acknowledge, or ignores, several of the claimed limitations and therefore fails to identify teachings that correspond to each of the claimed limitations. Applicant accordingly requests that the rejection of these dependent claims be withdrawn.

With respect to the § 103(a) rejection of dependent Claims 8, 27 and 37 based upon the teachings of Littleton combined with those of U.S. Publication No. 2003/0220966 by Hepper *et al.* (hereinafter “Hepper”), Applicant traverses as the asserted references alone, or in combination, do not teach each of the claimed limitations. As discussed above, Littleton fails to at least teach forming binding between a user data unit and a function of a second device in the second device, as claimed. As Hepper has not been shown, and does not appear, to teach at least these absent limitations, the further reliance on Hepper does not overcome the above-discussed deficiencies in the § 103(a) rejections. Therefore, the rejection is improper, and Applicant requests that the rejection be withdrawn.

In addition to the lack of correspondence between Littleton and the claimed invention, the assertion that the asserted binding data of Littleton would/could be synchronized separately is incorrect and fails to recognize the claimed invention. Since Littleton’s phone numbers (asserted user data units) are part of the contact records (asserted binding data) the synchronization of the data units between the PDA and PC includes synchronization of the contact records – they are not separate data such that they could not be synchronized separately as asserted. Contrary to Littleton’s single synchronization step, there is a specific relationship between the claimed separate synchronization steps, as discussed, for example, in paragraph [0017] of the Specification. A skilled artisan would not modify the teachings of Littleton as asserted, but if he/she did, such modification would not correspond to the claimed invention.

It should be noted that Applicant does not acquiesce to the Examiner’s statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant’s invention, officially

noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

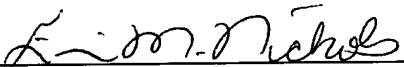
With particular respect to Claims 19-26, 28-36 and 38, Applicant notes that these claims are not included in any of the statements of rejection. MPEP § 707.07(d) indicates that where a claim is refused the word "reject" must be used and the statutory basis for any ground of rejection should be designated by an express reference in the opening sentence of each ground of rejection. While it appears that the Examiner intended to reject Claims 19-26, 28-36 and 38 upon the same basis of the rejection of Claims 1-7 and 9-18, such a rejection would be improper for the reasons discussed above in connection with the failure of the asserted reference to correspond to the claimed invention. If this was not the Examiner's intention, Applicant requests clarification, an opportunity to respond, and that any future rejections comply with MPEP § 707.07(d).

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.054PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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